

REMARKS

This is a full and timely response to the non-final Office Action mailed February 27, 2004 (Paper No. 21). Claims 1-2, 5-7, 10, 13-17, 19-22, 24, 25 and 27-34 are currently pending in this application, with claims 1, 5, 15 and 22 being independent. Claims 1, 5, 15, 16 and 22 are currently amended. This paper requests the reconsideration of certain findings of fact made in connection with the rejection of the claims. Reexamination and reconsideration in light of the following remarks are respectfully requested.

Claim Rejections- 35 U.S.C. § 103

In the Action, claims 1, 2, 5-7, 10, 13, 15-17, 19, 22, 24, 25 and 27-34 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Reissue Patent No. RE 37, 131E to Mankovitz ("Mankovitz") in view of U.S. Patent No. 5,918,213 to Bernard et al. ("Bernard"). This rejection is respectfully traversed.

Independent claim 1 of the present invention recites a method of providing listeners with information about audio programming being digitally broadcast comprising combining a data signal carrying contextual information about the audio programming with an audio signal carrying the audio programming; broadcasting the combined data and audio signals; receiving the combined data and audio signals from a service provider with a receiver; separating the data and audio signals; transducing the audio signal into audible sound; displaying the contextual information about the audio programming on a display device of the receiver; storing at least a portion of the contextual information of the data signal onto a removable memory medium; and transmitting a purchase signal to the service provider indicating an order to purchase a recording of the broadcast audio programming that is indicated by the contextual information being displayed on the display device.

The present invention allows for the simultaneous broadcast and reception of an audio signal and its related contextual information such that the audio signal may be transduced into audible sound at the same time the contextual information is displayed on a display device. *See* page 10, line 13 to page 11, line 21. In addition, users may input a request to purchase the audio programming being broadcast, indicated by the contextual information displayed on the display device, such that a purchase signal may be transmitted to a service provider indicating an order

to purchase a recording of the audio programming being broadcast. *See* page 14, line 14 to page 15, line 22.

In contrast, Mankovitz and Bernard, either alone or in combination, fail to disclose, teach or suggest at least the step of transmitting a purchase signal to a service provider indicating an order to purchase a recording of broadcast audio programming indicated by the contextual information being displayed on a display device, at least a portion of which information is stored onto a removable memory medium.

Mankovitz arguably teaches of a method and apparatus for music and lyrics broadcasting wherein lyrics and text may be stored in a storage medium. However, as conceded on page 3 of the outstanding Action, Mankovitz fails to disclose, teach or suggest storing at least a portion of the contextual information of the data signal onto a ***removable memory medium***, as is recited in claim 1 of the present invention.

Bernard arguably teaches of a system and method for automated remote previewing and purchasing of music and other multimedia products, wherein an interactive transaction database is provided for storing important information regarding the system and its customers. *See* col. 5, lines 2-6. However, Bernard clearly fails to disclose teach or suggest storing at least a portion of the contextual information of the data signal onto a removable memory medium.

In an attempt to remedy this conceded deficiency, the examiner alleges that it “is well known in the technology that the removable storage, cassette, can be used with [an] FM receiver.” Although it is arguably well known in the prior art to store ***audio programming*** onto a removable storage medium, such as the cassette referenced by the examiner, the examiner has failed to point to a specific reference as disclosing, teaching or suggesting storing at least a portion of ***contextual information of a broadcast data signal*** onto a removable memory medium, as is recited in claim 1 of the present invention.

Most importantly, the examiner has failed to point to or provide any reason why one of ordinary skill in the art would have been led to modify the Mankovitz and/or Bernard references in the manner suggested, as has been required by the Federal Circuit and the Board of Patent Appeals and Interferences. *See Ex Parte Clapp*, 227 USPQ 972, 973 (Bd.Pat.App. & Interf. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art, and not from the Applicant’s disclosure. *See In re Rouffet*, 149 F.3d 1350, 1354 (Fed. Cir. 1998). With regards to the present rejection, no such findings have been made.

In addition to the above, Mankovitz and Bernard, either alone or in combination, fail to disclose, teach or suggest transmitting a purchase signal to a service provider indicating an order to purchase a recording of broadcast audio programming indicated by contextual information being displayed on a display device, as is recited in claim 1 of the present invention.

As conceded on pages 3 and 4 of the Action, Mankovitz fails to disclose, teach or suggest transmitting a purchase signal to a service provider indicating an order to purchase a recording of the broadcast audio programming indicated by contextual information being displayed on a display device. Furthermore, the Bernard reference clearly fails to remedy the conceded deficiencies of Mankovitz.

Although Bernard arguably teaches of an automated product purchasing system that allows purchasers to order products via a remote communications medium, Bernard fails to disclose, teach or suggest transmitting a purchase signal to a service provider indicating an order to purchase *a recording of broadcast audio programming indicated by contextual information being displayed on a display device*. The purchasing system disclosed in Bernard requires a user to: 1) first connect to the system via either a network connection or phone line, 2) manually search for and request media content to be previewed or sampled, 3) download the requested sample data, before 4) inputting a request to purchase the sampled media content. *See* col. 3, lines 8-40. No provision is made by Bernard for allowing a user to transmit a purchase signal to a service provider to purchase digitally broadcast audio programming indicated by the contextual information displayed on a display device.

Most importantly, the examiner has failed to point to or provide any reason why one of ordinary skill in the art would have been led to modify and/or combine the Mankovitz and Bernard references in the manner suggested, as has been required by the Federal Circuit and the Board of Patent Appeals and Interferences. As discussed previously, this motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art, and not from the Applicant's disclosure. Such findings have not been made.

Thus, for at least the foregoing reasons, Mankovitz or Bernard, either alone or in combination, fail to disclose, teach or suggest at least the steps of storing at least a portion of the contextual information of the data signal onto a removable memory medium and transmitting a purchase signal to a service provider indicating an order to purchase a recording of broadcast audio programming indicated by contextual information being displayed on a display device, as

is recited in claim 1 of the present invention. Accordingly, since the applied art fails to teach each and every limitation recited in claim 1, and further since the requisite motivation to modify or combine the prior art references has not been demonstrated, a prima facie rejection of the claims has not been established. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Accord. M.P.E.P. § 2143.03. Withdrawal of this rejection is therefore respectfully requested.

Independent claim 5 recites, *inter alia*, a receiver for receiving a broadcast signal which is an audio signal and a data signal combined, a memory cartridge for storing at least a portion of contextual information of the data signal, wherein the memory cartridge is a removable memory cartridge, and a user input device for controlling transmission of the contextual information over a connection to a service provider and for generating requests to be transmitted to the service provider to purchase a recording of the particular audio programming.

For reasons essentially similar to those set forth above with respect to the rejection of claim 1, Mankovitz and Bernard, either alone or in combination, fail to disclose, teach or suggest a removable memory cartridge for storing at least a portion of contextual information of a data signal, and transmitting contextual information over a connection to a service provider for generating requests to be transmitted to the service provider to purchase a recording of a particular audio programming, as is recited in claim 5 of the present invention. Arguments in support of the allowability of claim 5 are hereby incorporated by reference to those arguments made in support of claim 1, *supra*.

Independent claim 15 recites, *inter alia*, a method for receiving a broadcast signal comprising storing at least a portion of contextual information of a data signal in a removable memory cartridge and transmitting a purchase signal to a service provider indicating an order to purchase a recording of an audio programming that is indicated by the contextual information being displayed on a display device.

For reasons essentially similar to those set forth above with respect to the rejection of claim 1, Mankovitz and Bernard, either alone or in combination, fail to disclose, teach or suggest storing at least a portion of contextual information of a data signal in a removable memory cartridge and transmitting a purchase signal to a service provider indicating an order to purchase a recording of an audio programming that is indicated by the contextual information being

displayed on a display device, as is recited in claim 15 of the present invention. Arguments in support of the allowability of claim 15 are hereby incorporated by reference to those arguments made in support of claim 1, *supra*.

Independent claim 22 recites, *inter alia*, a receiver for receiving a broadcast signal comprising means for storing at least a portion of contextual information of a data signal, wherein the storing means is removable, and means for transmitting at least a portion of the contextual information to a service provider to purchase a recording of an audio programming.

For reasons essentially similar to those set forth above with respect to the rejection of claim 1, Mankovitz and Bernard, either alone or in combination, fail to disclose, teach or suggest storing at least a portion of contextual information of a data signal, the storing means being removable, and means for transmitting at least a portion of the contextual information to a service provider to purchase a recording of an audio programming, as is recited in claim 22 of the present invention. Arguments in support of the allowability of claim 22 are hereby incorporated by reference to those arguments made in support of claim 1, *supra*.

Moreover, aside from the novel limitations recited therein, claims 2, 6, 7, 10, 13, 16, 17, 19, 24, 25 and 27-34, being dependent either directly or indirectly upon allowable base claims 1, 5, 15 or 22, are also allowable for at least the reasons set forth above. Withdrawal of the rejection of these claims is therefore respectfully requested.

Claims 14 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mankovitz in view of Bernard and U.S. Patent No. 5,239,540 to Rovira et al. ("Rovira"). This rejection is respectfully traversed. Aside from the novel limitations recited therein, claims 14 and 20, being dependent either directly or indirectly upon allowable base claims 5 or 15, are also allowable for at least the reasons set forth above. Withdrawal of the rejection of these claims is therefore respectfully requested.

Claim 21 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Mankovitz in view of Bernard and U.S. Patent No. 6,314,573 to Gordon et al. ("Gordon"). This rejection is respectfully traversed. Aside from the novel limitations recited therein, claim 21, being dependent upon allowable base claim 15, is also allowable for at least the reasons set forth above. Withdrawal of this rejection is therefore respectfully requested.

Conclusion:

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Applicant believes no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SOA-246, from which the undersigned is authorized to draw.

Dated:

May 10, 2004

Respectfully submitted,

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